

REMARKS

Claims 2-8 and 10-40 are pending in this application. Claims 7-8 and 15-16 have been allowed without the necessity of amendments. The Examiner's indication of allowability of these claims is noted with appreciation. For purposes of expedition, claims 1 and 37 have been amended to correct a typographical error and to provide proper antecedent basis for a term defined. Accordingly, entry of the foregoing amendments is proper under 37 C.F.R. §1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove §112 issues.

Claims 2-3, 10, 17-19, 21-34 and 37 have been rejected under 35 U.S.C. §103 as being unpatentable over Sawada et al., U.S. Patent Application Publication No. 2001/0021663, in view of Maekawa, U.S. Patent No. 5,490,202. In support of the rejection of base claims 2, 10 and 23, the Examiner asserts that Sawada '663, as primary reference, discloses an electronic apparatus comprising:

"an electronic device including a body (see 21, fig. 8); and
a battery (22) coupled to the body to supply current to said electronic device, said battery further comprising a memory unit (42, 43, fig. 8) to store information (see par. 0041, 0055)."

However, the Examiner has expressly admitted that Sawada '663 fails to disclose that the battery further comprises "a secondary power output port to connect to another device having a controller to supply current thereto to power the controller" but cited column 6, lines 35-41 of Maekawa '202 for allegedly disclosing such features. This rejection is respectfully traversed, however. Applicants note that such features are **not** disclosed or suggested by Maekawa '202, whether taken individually or in combination with any other references of record and, as a result, request the Examiner to reconsider and withdraw this rejection for the following reasons.

Base claims 3, 10 and 23 expressly define that the battery for an electronic device is only provided with (1) a primary power connector used to power the electronic device, but also (2) a secondary power output port 211, as shown, for example, in FIG. 2, FIG. 3, FIGs. 4A-4B and FIG. 6, used to advantageously allow connection with another [electronic] device having a controller to supply current thereto to power the controller [of the another electronic device], as

shown in FIG. 6. This way the same battery can advantageously serve as a power source to at least two different electronic devices, that is, an electronic device in which it is attached to and intended for operation, and another, i.e., a different electronic device 300, such as a portable phone, a notebook computer or a PDA, as shown in FIG. 6, particularly, in the event where information contained in the memory unit of the battery needs to be shared or exchanged with the another electronic device 300. Power from the same battery can be provided to both electronic devices.

In contrast to Applicants' base claims 3, 10 and 23, Sawada '663, as a primary reference, simply discloses the use of a battery pack, as shown in FIG. 2 and FIG. 4, including a battery for supplying electric power.

As a secondary reference, Maekawa '202 only discloses the use of an additional device 30, as shown, in FIG. 6 and FIG. 14, arranged between a portable telephone main body 10 and a battery 20 that is detachable from the portable telephone main body 10. Such an additional device 30, as shown in FIG. 13, has its own power source section 34a independently from the battery 20. As succinctly described by Maekawa '202, on column 5, lines 5-10,

"[T]he installation of the additional device 30a for the portable telephone permits **prolonging a stand-by time and a conversation talk time** which have been short in the case of using the battery 20 alone. That is, this principle is equal to the parallel connection of dry cells, whereby a telephone use time can be prolonged."

In other words, the purpose of the installing an additional device 30 as described by Maekawa '202 is to provide an additional power source, should the power of the battery 20 become insufficient.

Simply, there is no disclosure anywhere from Maekawa '202 of Applicants' claimed "battery" comprising "a secondary power output port to connect to another device having a controller to supply current thereto to power the controller". Nevertheless, the Examiner cites column 6, lines 35-41 for allegedly disclosing such features. However, the Examiner's citation is misplaced. Specifically, the cited column 6, lines 35-41, Maekawa '202 describes that,

"a switch 38b disconnects the power source feed line extending to the battery 20 by the operation of the internal circuit and connects a line extending to the external power source 45, so that the feed of the power source to the additional device 30b for the portable telephone can be achieved by feeding the power source to the internal circuit 32b via the connectors 55, 53 and the switch 38b. The feed of the power source to the portable telephone main body 10 is achieved by feeding the power source to the internal circuit 13 via the connectors

53, 51."

In other words, the cited column 6, lines 35-41 of Maekawa '202 simply refers to an alternative embodiment, as shown in FIG. 19, in which **an external power source 45** is further utilized. As a result, a switch 38b is used to enable the portable telephone main body 10 to receive power either from the detachable battery 20, or alternatively, the **newly connected external power source 45**.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Examiner must show that the prior art reference (or references when combined) must teach or suggest all the claim limitations, and that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, provided with a reasonable expectation of success, in order to arrive at the Applicants' claimed invention. The requisite motivation must stem from some teaching or suggestion to make the claimed combination must be found in the prior art, and **not** based on Applicants' disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 2143. In other words, all the claim limitations must be disclosed or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385, 165 USQP 494, 496 (CCPA 1970).

Moreover, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." ACS Hospital System, Inc v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). The Examiner must point to something in the prior art that suggests in some way a modification of a particular reference or a combination of references in order to arrive at Applicants' claimed invention. Absent such a showing, the Examiner has improperly used Applicants' disclosure as an instruction book on how to reconstruct to the prior art to arrive at Applicants' claimed invention. Furthermore, any deficiencies in the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge". In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002).

In the present situation, both Sawada '663 and Maekawa '202 fail to disclose and suggest key features of Applicants' base claims 2, 13 and 23. Therefore, Applicants respectfully request that the rejection of base claims 2, 13 and 23 and their respective dependent claims be withdrawn.

Dependent claims 3 and 11 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada et al. in view of Japanese Patent No. 2000165513A for reasons stated on pages 5-6 of the final Office Action (Paper No. 52405). In response thereto, Applicants respectfully traverse noting that neither Sawada '663 nor Japanese Patent No. 2000165513A discloses Applicants' claimed "secondary power output port to connect to another device having a controller to supply current thereto to power the controller" as defined in base claims 2 and 10, and for reasons discussed previously.

Dependent claims 4-5 and 12-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Sawada et al., Maekawa and further in view of Johnson et al., U.S. Patent No. 6,524,122 for reasons stated on pages 6-7 of the final Office Action (Paper No. 52405). Similarly, dependent claims 6, 9, 14, 31 and 33 have been rejected under 35 U.S.C. §103 as being unpatentable over Sawada et al. in view of Miyoshi et al., U.S. Patent Application Publication No. 2001/0044331 for reasons stated on pages 7-8 of the final Office Action (Paper No. 52405). Dependent claim 20 has been rejected under 35 U.S.C. §103 as being unpatentable over Sawada et al. in view of Tringali et al., U.S. Patent No. 6,545,891 for reasons stated on pages -89 of the final Office Action (Paper No. 52405). Lastly, dependent claims 35-36 and 38-40 have been rejected under 35 U.S.C. §103 as being unpatentable over Sawada et al. in view of Maekawa and further in view of Wang, U.S. Patent Application Publication No. 2003/0013506. Since these rejections are predicated upon the correctness of the rejection of Applicants' base claims 2, 10 and 23, which Applicants have demonstrated as being incorrect, Applicants respectfully traverse these rejections at least for the same reasons as discussed above.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney at the Washington DC office at (202) 216-9505. Applicants respectfully reserve all rights to file subsequent related application(s) (including reissue applications) directed to any or all previously claimed limitations/features which have been amended or canceled, or to any or all limitations/features not yet claimed, i.e., Applicants have no intention or desire to dedicate or surrender any limitations/features of the disclosed invention to the public.

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Respectfully submitted,

STEIN, MCEWEN & BUI, LLP

Date: 9/2/05

By: Hung H. Bui
Hung H. Bui
Registration No. 40,415

1400 Eye St., NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510